UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
CAMPBELL, JOSHUA D

ART UNIT	PAPER NUMBER
2179	

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/709,433	STEWART ET AL.
	Examiner	Art Unit
	Joshua D Campbell	2179

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>07 May 2004</u>.
2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>12-31</u> is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) <u>12-31</u> is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a) ☐ All   b) ☐ Some *   c) ☐ None of:
   1. ☐ Certified copies of the priority documents have been received.
   2. ☐ Certified copies of the priority documents have been received in Application No. _____.
   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
   application from the International Bureau (PCT Rule 17.2(a)).
   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)
1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: Amendment filed on 06/02/2004.

2.   Claims 12-31 are pending in this case. Claims 12, 17, 20, 24, 28, 29, and 31 are

independent claims. Claims 1-11 have been cancelled. Claims 12-31 have been

added.

3.   The rejection of claims 1-11 under 35 U.S.C. 102(e) as being anticipated by

Adamske et al. has been withdrawn due to the cancellation of those claims.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

6.   Claims 12-27 and 29-31 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Adamske et al. (US Patent Number 6,625,234, filed on May 11,

1999).

Regarding independent claim 12, Adamske discloses a method in which a user

uses software on a client device to generate a print file based on a document and a

preview is generated from the file (column 5, line 64-column 7, line 15 of Adamske).

The user then uploads the print file and configuration information to the server (column

5, line 64-column 7, line 15 of Adamske). Adamske does not directly disclose a method

in which a preview is generated by the server and provided to the user based on the

print file that was uploaded. However, Adamske discloses an alternate method in which

the server generates the print file and then from that print file and the configuration

information provided the server generates and provides a preview to the user (column

5, line 64-column 7, line 15 of Adamske). It would have been obvious to one of ordinary

skill in the art to combine the two methods of Adamske because it would have allowed

the client system to do less work in the process.

Regarding dependent claim 13, Adamske discloses a method in which a print

drive is installed on the client in order to generate the print file (column 5, line 64-column

7, line 15 of Adamske).

Regarding dependent claim 14, Adamske discloses a method in which a print

driver is installed on the client and a print file is generated using the print driver, at

which point the print file is uploaded to the server (column 5, line 64-column 7, line 15 of

Adamske). Adamske discloses a method in which the print driver necessary is automatically selected (column 5, line 64-column 7, line 15 of Adamske). Adamske does not disclose a method in which the print driver is listed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have allowed to have listed the print driver of Adamske because it would have allowed the user to see the format type the print file would be in.

Regarding dependent claim 15, Adamske discloses a method in which a user interface is generated that may be web based (on the server) (column 2, lines 4-60 of Adamske). The interface provides a preview section and a printing options section that allows a user to provide configuration information (i.e. style options) (column 7, lines 16-56 of Adamske). The interface is provided to the user via the Internet for display (column 2, lines 4-60 of Adamske).

Regarding dependent claim 16, Adamske discloses a method in which styles and printing options for the document are obtained and shown via the preview, which is then provided to the client (column 5, line 64-column 7, line 56 of Adamske).

Regarding independent claim 17, Adamske discloses a method in which a print file based on a document is uploaded to a server along with configuration information for the document (column 5, line 64-column 7, line 15 of Adamske). A plurality of copies is printed in accordance with a plurality of addresses that are obtained from the user (column 5, line 64-column 7, line 15 of Adamske). A coversheet (memo) is customized for each address is printed; at point all parts are delivered to the delivery addresses (column 7, lines 16-56 of Adamske). Adamske does not disclose that the customized

memo is obtained from the client. However, it would have been obvious to one of

ordinary skill in the art at the time the invention was made to have allowed the user to

create the custom memo on the client rather than the server because it would have

provided the user with more freedom of customization with the memo.

Regarding dependent claim 18, Adamske discloses a method in which the

server generates the print file and then from that print file and the configuration

information provided the server generates and provides a preview to the user ().

Adamske also discloses a method in which a user interface is generated that may be

web based (on the server) (column 5, line 64-column 7, line 15 of Adamske). The

interface provides a preview section and a printing options section that allows a user to

provide configuration information (i.e. style options) (column 5, line 64-column 7, line 56

of Adamske). The interface is provided to the user via the Internet for display (column

2, lines 4-60 of Adamske). Adamske also discloses a method in which styles and

printing options for the document are obtained and shown via the preview, which is then

provided to the client (column 7, lines 16-56 of Adamske).

Regarding dependent claim 19, Adamske discloses a method in which a print

drive is installed on the client in order to generate the print file (column 5, line 64-column

7, line 15 of Adamske). Adamske discloses a method in which a print driver is installed

on the client and a print file is generated using the print driver, at which point the print

file is uploaded to the server (column 5, line 64-column 7, line 15 of Adamske).

Adamske discloses a method in which the print driver necessary is automatically

selected (column 5, line 64-column 7, line 15 of Adamske). Adamske does not disclose

a method in which the print driver is listed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have allowed to have listed the print driver of Adamske because it would have allowed the user to see the format type the print file would be in.

Regarding independent claim 20 and dependent claims 21-23, the claims incorporate substantially similar subject matter as claims 12-15. Thus, the claims are rejected along the same rationale as claims 12-15.

Regarding independent claim 24, Adamske discloses a method in which a user uses software on a client device to generate a print file based on a document and a preview is generated from the file (column 5, line 64-column 7, line 15 of Adamske). The user then uploads the print file and configuration information to the server, at which point the document is printed and assembled based on configuration and style options (column 5, line 64-column 7, line 15 of Adamske). Adamske does not directly disclose a method in which a preview is generated by the server and provided to the user based on the print file that was uploaded. However, Adamske discloses an alternate method in which the server generates the print file and then from that print file and the configuration information provided the server generates and provides a preview to the user (column 5, line 64-column 7, line 15 of Adamske). It would have been obvious to one of ordinary skill in the art to combine the two methods of Adamske because it would have allowed the client system to do less work in the process.

Regarding dependent claim 25, Adamske discloses a method in which a print file based on a document is uploaded to a server along with configuration information

for the document (column 5, line 64-column 7, line 15 of Adamske). A plurality of copies

is printed in accordance with a plurality of addresses that are obtained from the user

(column 5, line 64-column 7, line 15 of Adamske). A coversheet (memo) is customized

for each address is printed; at point all parts are delivered to the delivery addresses

(column 7, lines 16-56 of Adamske). Adamske does not disclose that the customized

memo is obtained from the client. However, it would have been obvious to one of

ordinary skill in the art at the time the invention was made to have allowed the user to

create the custom memo on the client rather than the server because it would have

provided the user with more freedom of customization with the memo.

Regarding dependent claim 26, Adamske discloses a method in which

payment information is obtained for the copy and the payment is processed using that

information (column 6, line 58-column 7, line 15 of Adamske).

Regarding dependent claim 27, Adamske discloses a method in which the print

driver generates the print file and an upload manager communicates the file to the

server (column 5, line 64-column 7, line 15 of Adamske).

Regarding independent claim 29, Adamske discloses a method in which a user

uses software on a client device to generate a print file based on a document and a

preview is generated from the file (column 5, line 64-column 7, line 15 of Adamske).

The user then uploads the print file and configuration information to the server, at which

point the document is printed and assembled based on configuration and style options

(column 5, line 64-column 7, line 15 of Adamske). Adamske does not directly disclose a

method in which a preview is generated by the server and provided to the user based

on the print file that was uploaded. However, Adamske discloses an alternate method in which the server generates the print file and then from that print file and the configuration information provided the server generates and provides a preview to the user (column 5, line 64-column 7, line 15 of Adamske). It would have been obvious to one of ordinary skill in the art to combine the two methods of Adamske because it would have allowed the client system to do less work in the process.

Regarding dependent claim 30, Adamske discloses a method in which the document may be generated on the client and obtained from the client (column 5, line 64-column 7, line 15 of Adamske).

Regarding independent claim 31, Adamske discloses a method in which a print file based on a document is uploaded to a server along with configuration information for the document (column 5, line 64-column 7, line 15 of Adamske). A plurality of copies is printed in accordance with a plurality of addresses that are obtained from the user (column 5, line 64-column 7, line 15 of Adamske). A coversheet (memo) is customized for each address is printed; at point all parts are delivered to the delivery addresses (column 7, lines 16-56 of Adamske). Adamske does not disclose that the customized memo is obtained from the client. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have allowed the user to create the custom memo on the client rather than the server because it would have provided the user with more freedom of customization with the memo.

7.   Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Adamske et al. (US Patent Number 6,625,234, filed on May 11, 1999) in view of

Bresnan et al. (US Patent Number 5,873,073, issued on February 16, 1999 - IDS).

Regarding dependent claim 28, Adamske discloses a method in which the

server generates the print file and then from that print file and the configuration

information provided the server generates and provides a preview to the user (column

5, line 64-column 7, line 15 of Adamske). Adamske also discloses a method in which a

user interface is generated that may be web based (on the server) (column 2, lines 4-60

of Adamske). The interface provides a preview section and a printing options section

that allows a user to provide configuration information (i.e. style options) (column 5, line

64-column 7, line 15 of Adamske). The interface is provided to the user via the Internet

for display (column 2, lines 4-60 of Adamske). Adamske also discloses a method in

which styles and printing options for the document are obtained and shown via the

preview that may be navigated by selecting portions (navigation area), which is then

provided to the client (column 5, line 64-column 7, line 56 of Adamske). Adamske does

not disclose a method in which an estimate area displays an estimate of price based on

the configuration and print file. However, Bresnan discloses a method in which an

estimate is generated based on configuration and the file itself and presented to the

user (column 14, lines 10-58 of Bresnan). It would have been obvious to one of

ordinary skill in the art at the time the invention was made to have combined the

methods of Adamske with the method of Bresnan because it would have allowed the

user to see the price prior to the billing process.

Response to Arguments

8.   Applicant's arguments with respect to claims 12-31 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
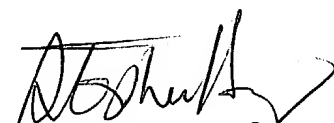
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D Campbell whose telephone number is (703)305-5764. The examiner can normally be reached on M-F (8:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Heather Herndon can be reached on (703)308-5186. The fax phone

number for the organization where this application or proceeding is assigned is 703-

872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

JDC
August 5, 2004

STEPHEN S. HONG
PRIMARY EXAMINER